

## **REMARKS**

Applicants respectfully request reconsideration of this application as amended. Claims 24 (second instance) – 39 have been renumbered 25-40, and claims 22, 26-29, and 31-40 have been amended. No claims have been added or cancelled by this amendment. Therefore, claims 22-40 are presented for examination.

The amendments to the claims to the claims made by this Response are not being made for the purpose of overcoming the prior art. Instead, these amendments are being made to clarify and/or correct claim formalities and/or objections raised by the Examiner.

### **Claim Objections**

The Examiner has objected to the numbering of claims. Specifically, claims 24 (second instance) – 39 were misnumbered. Applicants have corrected this, and respectfully request that the objection be withdrawn.

### **35 U.S.C. §103(a) Rejections**

In order to establish a *prima facie* case of obviousness:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (Emphasis added). *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Manual of Patent Examining Procedure (MPEP), 8<sup>th</sup> Edition, August 2001, §2143.

***Popelka in view of Bergsten***

Claims 22-25, 27, 29-30, and 40 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Popelka et al. (U.S. Patent No. 6,081,883, hereinafter "Popelka") in view of Bergsten (U.S. Patent No. 6,360,306).

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation in Popelka or Bergsten for modification or combination.

There is no suggestion or motivation in Popelka or in Bergsten for modification or combination

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP §2143.01. Furthermore, though a combined element may be a "technologically simple concept", the reference must still provide the motivation for the combination. (*In re Kotzah*, 217 F.3d at 1371, 55 USPQ2d at 1318.) MPEP §2143.01.

Popelka discloses a file server architecture in which a network processor (NP) on a system services requests from clients by using a file server processor (FSP) on the system to service clients' requests. Bergsten discloses a distributed storage system for storing back-up copies of data.

In Popelka, when a client sends a request, an NP processes the request by interfacing with an FSP. The FSP is connected to mass storage devices (disks 150, 152, 154, and 156, Popelka, column 3, lines 1-3, and column 5, lines 45-58), and can complete operations associated with the request. The FSP sends a reply to the NP, and the NP then sends a reply to the client. Popelka, FIGS. 9a, 9b, 10-13, column 15, line 23 – column 17, line 25.

Using this architecture, Popelka purports to address the issue of "data consolidation" (Popelka, for example see Abstract, last line; column 2, lines 31-33; and column 3, lines 61-63.) Consequently, Popelka lacks any suggestion or motivation for combination with a storage system in which storage is "geographically remote to each other", as provided by Bergsten because Popelka teaches away from such a combination. ("It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769,779 (Fed. Cir. 1983)", MPEP §2145(X)(D)(2).)

Furthermore, Bergsten lacks any suggestion or motivation for combination with Popelka. As indicated above, Bergsten is directed to storing back-up copies of data in geographically dispersed locations. Therefore, Bergsten also teaches

away from combination with a file server architecture in which storage is located on a single computer system, as provided by Popelka.

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation in Popelka nor Bergsten to modify the references, or to combine the teachings of Popelka and Bergsten.

***Popelka in view of Bergsten and Gall***

Claim 26 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Popelka in view of Bergsten and Gall et al. (U.S. Patent No. 6,356,929, hereinafter "Gall").

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation in Popelka, Bergsten, or Gall for modification or combination.

There is no suggestion or motivation in Popelka, Bergsten or Gall to modify the references, or to combine the teachings of Popelka, Bergsten and Gall

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP §2143.01. Furthermore, though a combined element may be a "technologically simple concept", the reference must still provide the motivation for the combination. (*In re Kotzah*, 217 F.3d at 1371, 55 USPQ2d at 1318.) MPEP §2143.01.

As indicated above, neither Popelka nor Bergsten provides the motivation for combination with one another. Therefore, whether or not Gall provides the suggestion or motivation for combination with Popelka or Bergsten is a moot issue since the combination of Popelka and Bergsten is not suggested or motivated.

Therefore, Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation in Popelka, Bergsten nor Gall to modify the references, or to combine the teachings of Popelka, Bergsten, and Gall.

***Popelka in view of Bergsten and Tzelnic***

Claim 28 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Popelka in view of Bergsten and Tzelnic et al. (U.S. Patent No. 5,948,062, hereinafter "Tzelnic").

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation in Popelka, Bergsten, or Tzelnic for modification or combination.

There is no suggestion or motivation in Popelka, Bergsten or Tzelnic to modify the references, or to combine the teachings of Popelka, Bergsten and Tzelnic

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.

Cir. 1990). MPEP §2143.01. Furthermore, though a combined element may be a "technologically simple concept", the reference must still provide the motivation for the combination. (*In re Kotzah*, 217 F.3d at 1371, 55 USPQ2d at 1318.) MPEP §2143.01.

As indicated above, neither Popelka nor Bergsten provides the suggestion or motivation for combination with one another. Therefore, whether or not Tzelnic provides the suggestion or motivation for combination with Popelka or Bergsten is a moot issue since the combination of Popelka and Bergsten is not suggested or motivated.

Therefore, Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation in Popelka, Bergsten, or Tzelnic to modify the references, or to combine the teachings of Popelka, Bergsten, and Tzelnic.

Therefore, for at least these reasons indicated above, Applicants respectfully submit that the Examiner's rejection of claims 22-40 (as well as the rejection of claims 31-39 for the same reasons indicated above) under U.S.C. 35 §103(a) should be withdrawn.

### **CONCLUSION**

Applicants respectfully submit that all of the Examiner's objections and rejections have been overcome, and that the claims, as amended, are in

condition for allowance. Accordingly, Applicants respectfully request the objection and rejections be withdrawn and the claims as amended be allowed.

The Examiner is invited to initiate an interview with the undersigned by calling 949-498-0601 if the Examiner believes that such an interview will advance prosecution of this application.

#### **Request for an Extension of Time**

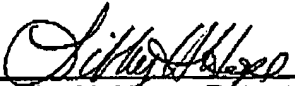
Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary.

**Charge our Deposit Account**

Please charge any shortage to our Deposit Account No. 50-0221.

Respectfully submitted,

Date: November 10, 2004

  
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